

REMARKS

Claims 1-21 are pending in the above-referenced application, and all of the claims are rejected.

Rejection under 35 U.S.C. 112, second paragraph

The Examiner rejects claims 17-21 based upon lack of antecedent basis for some terms. Applicants herein make the necessary minor amendments to provide proper antecedent basis thereby overcoming the rejection. In claims 17, 20 and 21, a "the" is changed to "a" to correct the error in antecedence.

Rejection under 35 U.S.C. 103(a)

Novak et al. in view of Delisle

The Examiner rejects claims 1-3, 5-7, 9-10, 12-14, and 17-21 under 35 U.S.C. 103(a) as unpatentable over Novak et al. in view of Delisle. According to the Examiner, it would have been obvious to exchange the glucose carbon source taught by Novak *et al.* for the sucrose carbon source taught by Delisle.

As the Examiner knows, in order to establish a proper *prima facie* case of obviousness, the Examiner must establish that there is a suggestion or motivation to modify the references or to combine the reference teachings; there must be a reasonable expectation of success; and the references or combination of references must teach or suggest all of the claim limitations (*see, e.g.,* MPEP § 2142). The teachings or suggestions to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure (*In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cr. 1991)). The arguments advanced by the Examiner fail to meet all of these criteria. There simply is no suggestion or expectation of success within the references cited for changing the glucose carbon source of Novak *et al.* for a sucrose carbon source.

The patent law is also quite clear that even if, *assuming arguendo*, there was a proper *prima facie* case of obviousness, secondary considerations may be used to rebut such a *prima facie* case. Among these secondary considerations are unexpectedly superior results. The methods of the prior art simply do not result in production levels as great as the instant invention as described in paragraph 10 of the specification. Therefore, even if, *assuming arguendo*, there were a proper *prima facie* case of obviousness, the present methods are rendered patentable because they produce unexpectedly superior production levels.

Qi et al. in view of DeVuyst et al.

The Examiner rejects claims 1-21 under 35 U.S.C. 103(a) as unpatentable over *Qi et al.* in view of *DeVuyst et al.* According to the Examiner, it would have been obvious to exchange the glucose carbon source taught by *Qi et al.* for the sucrose carbon source taught by *DeVuyst et al.*

As set forth above, in order to establish a proper *prima facie* case of obviousness, the Examiner must establish that there is a suggestion or motivation to modify the references or to combine the reference teachings; there must be a reasonable expectation of success; and the references or combination of references must teach or suggest all of the claim limitations (*see, e.g.,* MPEP § 2142). The teachings or suggestions to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure (*In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cr. 1991)). The arguments advanced by the Examiner fail to meet all of these criteria. There simply is no suggestion or expectation of success within the references cited for changing the glucose carbon source of *Qi et al.* for a sucrose carbon source.

The patent law is also quite clear that even if, *assuming arguendo*, there was a proper *prima facie* case of obviousness, secondary considerations may be used to rebut such a *prima facie* case. Among these secondary considerations are unexpectedly superior results. The

methods of the prior art simply do not result in production levels as great as the instant invention as described in paragraph 10 of the specification. Therefore, even if, *assuming arguendo*, there were a proper *prima facie* case of obviousness, the present methods are rendered patentable because they produce unexpectedly superior production levels.

Conclusion

Applicants believe that the foregoing amendments to the claims place the application in condition for allowance. Withdrawal of the rejections and objections is respectfully requested. If a discussion with the undersigned will be of assistance in resolving any remaining issues, the Examiner is invited to telephone the undersigned at (201) 487-5800, ext. 114, to effect a resolution.

Respectfully submitted,


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